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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,973	02/25/2004	Toshiaki Igarashi	03500.100142.	8991
5514 7590 12/04/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER NGUYEN, CINDY	
			ART UNIT 2161	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/784,973

Applicant(s)

IGARASHI, TOSHIAKI

Examiner

Cindy Nguyen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/07/07; 06/22/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

***This is respond to amendment filed 10/18/07.***

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 06/22/07 and 11/07/07. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Response to Arguments***

The rejection under section 112, second paragraph has been withdrawn.

Applicant's arguments fully considered but they are not persuasive.

Applicant argued that nothing in Metz that would teach or suggest : the features of claims 1, 2 9 and 13.

In respond, Metz discloses a network management tool 104 can send a query to all printing devices on network and listen for response, specific devices queries can be performed if there is a known address for a device, such as its IP address, or IPX address, IP host name, LAN hardware address, MAC address , Metz discovery techniques involving monitoring the network 100 involve listening for devices and updating the naming device list 302 each time a new printing device is discovered ([0022]). Metz teaches a network management device that periodically performs printer discovery and updates the main device list. User can create secondary lists by using some criterion to filters ([0024]). The filter queries (i.e., requests) the main device list (requests can be initiated by the user or periodically) ([0031]; [0032]). The user can

specify in the criterion that "give me a list of all LJ9000 printers" in the query request of the filter. The system will return a list of LJ9000 from the network and show on the screen (the list must be stored somewhere e.g., memory to be shown on the screen). If at a later time the user sends the same query request and a new printer of type LJ9000(i) has been added to the network in between the request times, the returned list will have a new printer, and the screen page would bolder (i.e., emphasize) the new printer (i.e., LJ900(i)) ([0040]) on the list. Therefor it is very clear that a comparison has occurred between the old list and the new list. Another user with the same query at a different time would see different printers emphasized. Finally Metz and the instant application are not only doing the same thing, but also resolving the same issue.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-, 2, 4-9, 11-17 stand rejected under 35 U.S.C. 102(e) as being anticipated by James Michael Metz, US Patent Publication No. 2004/0019671 and hereinafter referred to as Metz.

As to claims 1,2,6,9, 12 and 13, Metz teaches a network device (Fig. 4A; [0004]) managing apparatus comprising:

receiving unit adapted to receive a search request of network devices (Fig. 4A; [0004, 0024, 0025] and identification information of a data processing apparatus from the data processing apparatus(i.e., printing device information such as: a model type, hardware address, port, IP address, iP host, status of the printer device, 0021, 0022);

searching unit adapted to search network devices in response to the search request received by said receiving unit (i.e., filter queries the main device list for information that satisfies one or more criteria for each secondary list. (0024));

obtaining unit adapted to obtain a past device list (the main device list) associated with the identification information of the data processing apparatus received by said receiving unit (i.e., filter queries the main device list for information that satisfies one or more criteria for each secondary list. (0024, 0025)), the past device list indicating a search result at the time when searched before the search by said searching unit (i.e., network management tool 104 can send a query to all printing devices on network and listen for responses and/or can monitor the network for signals

indicating that printing devices are present on the network... discover new printer and updating the main device list (0022);

a comparing unit adapted to compare the search result by said searching unit with the past device list obtained by said obtaining unit (Metz teaches a network management device that periodically performs printer discovery and updates the main device list. User can create secondary lists by using some criterion to filters ([0024]). The filter queries (i.e., requests) the main device list (requests can be initiated by the user or periodically) ([0031]; [0032]). The user can specify in the criterion that "give me a list of all LJ9000 printers" in the query request of the filter. The system will return a list of LJ9000 from the network and show on the screen (the list must be stored somewhere e.g., memory to be shown on the screen). If at a later time the user sends the same query request and a new printer of type LJ9000(i) has been added to the network in between the request times, the returned list will have a new printer, and the screen page would bolder (i.e., emphasize) the new printer (i.e., LJ900(i)) ([0040]) on the list. Therefor it is very clear that a comparison has occurred between the old list and the new list. Another user with the same query at a different time would see different printers emphasized.;

a forming unit adapted to specify from among the network devices searched by said searching unit the network device not presented in the past device list, and forming a device list in which the specified network device has been emphasized (0025, 0040) ; and

Transmitting unit adapted to transmit the device list formed by said forming unit to said data processing apparatus (i.e., displayed in the users' or administrators' computer screen) (Fig. 6).

As to claims 4,7 and 11, Metz teaches wherein the device list formed by said data forming means includes an emphasis mark to emphasize ([0040]).

As to claims 5 and 8, Metz teaches wherein the device list formed by said data forming means includes instruction data for allowing a device icon of the data processing apparatus to be displayed in an updated state (Fig. 5).

As to claims 14 and 16, Metz teaches wherein said obtaining unit obtains the past device list held by said holding unit (i.e., the network management tool 104 tool creates a main device list 302, by discovering all the printing devices on the network 100 and then recording information associated with the printing devices 102 in the main device list 302, 0021).

As to claims 15 and 17, Metz teaches wherein the identification information is a network address of the data processing apparatus (i.e., printing device information such as IP address, IP host, hardware address, 0021).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over James Michael Metz, US Patent Publication No. 2004/0019671 and hereinafter referred to as Metz in view of Boldt et al. (US 6349304) (hereafter Boldt).

As to claims 3 and 10, Metz didn't teaches wherein the device list formed by said forming unit indicates at least one of information regarding whether printing is possible or not and an error state. On the other hand, Boldt discloses: wherein the device list formed by said forming unit indicates at least one of information regarding whether printing is possible or not and an error state (i.e., indicated whether the printer 8a, b,c,d should continue printing after a printing error, col. 4, lines 42-48). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include said list indicates at least one of information regarding whether printing is possible or not and an error state in the system of Metz as taught by Boldt. The motivation being to determined set of features may be transmitted to different target devices when the target devices have different capabilities with respect to the determined set of features, the target devices are configured with the values transmitted over the network, col. 1, lines 57-62, Boldt.



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**Contact information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on 8:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Cindy Nguyen



ETIENNE LEROUX  
PRIMARY EXAMINER